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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,118	09/12/2003	Paul O. Davison	A-21-1	6449

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EXAMINER

ROLLINS, ROSILAND STACIE

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/661,118	Applicant(s) DAVISON ET AL.	
	Examiner Rosiland S. Rollins	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>IDS 10/14/03</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately disclose a fluid entry port on a tissue-contacting surface, a fluid vent port on a second surface opposing the tissue-contacting surface, and a central void connecting the entry port to the vent port.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1, 10, 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanton et al. (US 6068628). Fanton et al. disclose an electrosurgical instrument for applying electrical energy to tissue comprising a tissue-contacting surface (18), at least one active electrode (22) recessed within the tissue-contacting surface and having a curved configuration and a return electrode (24) positioned about the tissue-contacting surface. Fanton et al. teach all of the limitations of the claims except the return electrode having an exposed surface area substantially larger than the active electrode. To have provided the return electrode with a larger surface area would have been obvious to one of ordinary skill in the art since it has been held that changing the size involves only routine skill.

Claims 1, 2, 3, 4, 5, 6-9, 11, 12, 15 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 4381007). In figures 7 & 8, Doss discloses an electrosurgical instrument for applying electrical energy to tissue comprising a tissue-contacting surface (70), at least one active electrode (72) recessed within the tissue-contacting surface and having a curved configuration, a return electrode (74) spaced apart from the at least one active electrode and a vent (80). Doss teaches all of the limitations of the claims except the return electrode having an exposed surface area substantially larger than the active electrode. To have provided the return electrode with a larger surface area would have been obvious to one of ordinary skill in the art since it has been held that changing the size involves only routine skill.

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Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fanton et al. in view of Doss. Fanton et al. teach all of the limitations of the claim except a fluid source for providing electrically conductive fluid between the return electrode and the at least one active electrode. Doss teaches that it is old and well known in the art to provide a source of electrically conductive fluid between the return electrode and the active electrode to cool and protect the tissue. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a source of electrically conductive fluid with the Fanton et al. device as taught by Doss to protect the tissue being treated.

Claims 21-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Fanton et al. Fanton et al. teach all of the limitations of the claims except the support being ceramic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a ceramic material for the insulative support of Fanton et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Response to Arguments

Applicant's arguments filed 7/13/06 have been fully considered but they are not persuasive.

Applicant argues that the cited references do not show a return electrode having an exposed surface area that is substantially larger than that of the active electrode. Examiner has addressed this argument in the new 103 rejections of claim 1. Applicant

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also argues that Doss provides an elongate tube and thereby does not show an annular support having a void connecting two ports. In figure 1 of Doss, a void is illustrated at the distal end of the device, which inherently connects the two ports (92 & 94).

Regarding the argument that Fanton does not appear to recite an annular support, in figure 8 Fanton clearly illustrates an annular support.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosiland S Rollins
Primary Examiner
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